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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,423	05/10/2001	Michael M. Tso	031792-0311553	7666
909 7590 09/30/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER HAVAN, THU THAO				
ART UNIT 3693		PAPER NUMBER		
MAIL DATE 09/30/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/854,423

Applicant(s)

TSO, MICHAEL M.

Examiner

THU-THAO HAVAN

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-9, 11-15, 17-23, 25-29, 31-37 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Response to Amendment

Claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 are pending. This action is in response to the remarks received on June 26, 2008.

Response to Arguments

The rejection of claims 1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41 under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 6,061,660) in view of Dethloff (US 4,968,873) is maintained.

Applicant's arguments filed June 26, 2008 have been fully considered but they are not persuasive.

In response to the arguments concerning the previously rejected claims the following comments are made:

A.) Applicant alleges that the prior art made of record fails to teach intermediary. The examiner disagrees with applicant's representative since Eggleston discloses intermediary in relation to communication links in a network (fig. 2). In the specification of the pending application, Applicant stated in paragraphs 0021 which defines intermediary as "Participant 204 is communicatively coupled to intermediary 206 via a communications link 210. Communications links 208, 210 may be implemented by any medium or mechanism that provides for the exchange of data between participant 202 and intermediary 206 and between participant 204 and intermediary 206, respectively. Examples of communications links 208, 210 include, without limitation, any number of networks, such as Local Area Networks (LANs), Wide Area Networks (WANs),

Ethernets or the Internet, or one or more terrestrial, satellite or wireless links." Thus, in figure 2, element 38, an intermediary as claimed corresponds to a telecommunications connections in Eggleston since they are both a connection to link information between users.

B.) Applicant alleges that the prior art made of record fails to teach not recognized by the second participant. The examiner disagrees with applicant's representative since Eggleston discloses the step of not recognized by the second participant (col. 46, lines 4-55) when he discloses the step of reducing the points in the card as awards are being granted to the user. He discloses loyalty points can be awarded for participation with respect to multiple retailers, and merchandise can be awarded by the sponsor offering the incentive program or by third party retailers.

With regards to the claims rejected as taught by Eggleston and Dethloff, the examiner would like to point out that the reference teaches the claimed limitations and thus provides adequate support for the claimed limitations. Therefore, the examiner maintains that on and Dethloff taught the claimed limitations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1, 3-9, 11-15, 17-23, 25-29, 31-37, and 39-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 6,061,660) in view of Dethloff (US 4,968,873).

Re claims **1, 15, and 29**, Eggleston teaches a method for processing a transaction (col. 44, lines 40-49), the method comprising the computer implemented steps of:

receiving at an intermediary (fig. 2, element 38; An intermediary as claimed corresponds to a telecommunications connections in Eggleston since they are both a connection to link information between users), from a first participant in the transaction, a request to process the transaction using a first currency that is not recognized by a second participant in the transaction (col. 44, line 64 to col. 45, line 67; Eggleston discloses a card with userid and password wherein the user obtain incentive points to redeem the award/money at any retails. Thus one retail doesn't necessary recognize another retailers' redemption points but accepts the incentive points due to the points in the card);

in response to receiving the request from the first participant, decrementing, by the intermediary (please see above explanation), an amount of the first currency associated with the first participant by decrementing a balance of a first currency account of the first participant, and incrementing, by the intermediary (please see above explanation), an amount of second currency associated with the first participant by incrementing a balance of a second currency account of the first participant, wherein the second currency is recognized by the second participant (col. 46, lines 4-55; Eggleston discloses the step of reducing the points in the card as awards are being granted to the user).

However, Eggleston does not explicitly teach processing the transaction using the amount of second currency associated with the first participant. On the other hand, Dethloff discloses processing the transaction using the amount of second currency associated with the first participant (col. 4, line 29 to col. 6, line 49). Dethloff discloses the cardholder or the issuer, after issuance or re-issuance of the card, to assign different values to one unit, change the designations of units and assign additional designation to a unit, all within the scope of the original extent of terms, and credit values initialized or reissued by the issuer(s). The capabilities of the card, namely to be assignable to sub-users (i.e. participant) and to be alterable as to the values and designations of the stored units, can be provided in individual (single) or in combinational (multi-user-value-card). Thus, it would have been obvious to one of ordinary skill in the art to process the transaction using the amount of second currency associated with the first participant when using a multi-user-value-card to assign different values to a plurality of retailers as discloses in Dethloff.

Re claims **3, 17, and 31**, Eggleston teaches amount of second currency incremented by the intermediary is determined based upon at least the amount of first currency decremented by the intermediary (col. 44, line 64 to col. 45, line 67).

Re claims **4, 18, 32**, Eggleston teaches amount of second currency incremented by the intermediary is determined based upon at least a set of one or more conversion criteria (col. 21, lines 4-28). Eggleston adding or deleting prizes or changing prices or fulfillment options in the incentive points according to user's criteria in receiving the award(s).

Re claims **5, 8, 19, and 33**, Eggleston teaches set of one or more conversion criteria includes a time at which the request from the first participant is received (col. 1, lines 46-62;

fig. 9). Eggleston discloses the time is required to keep track of loyalty points earned in each separate incentive program.

Re claims **6-7**, **20-22**, and **34-36**, Eggleston teaches set of one or more conversion criteria includes one or more attributes of the first/second participant (col. 41, lines 5-38; col. 27, lines 8-34; col. 25, lines 15-49). Eggleston discloses attributes by information and criteria of retailers.

Re claims **9**, **23**, and **37**, Eggleston teaches set of one or more conversion criteria includes which products or services are involved in the transaction (col. 41, lines 28-65; col. 42, lines 38-57).

Re claims **11**, **25**, and **39**, Eggleston teaches decrementing the balance of the first currency account and incrementing the balance of the second currency account are performed as an atomic transaction (col. 46, lines 4-55). Eggleston calculations and printed invoices for payment by a financial institution to an incentive company based on the credit instruments issued under the incentive program are made and are dependent upon the monetary volume of expenditures.

Re claims **12-13**, **26-27**, and **40-41**, Eggleston teaches if the transaction is not successfully processed, then incrementing the first currency associated with the first participant by the amount of first currency that was previously decremented (col. 21, lines 4-28). Eggleston discloses the retailer may elect to update the award database by adding or deleting prizes or changing prices or fulfillment options.

Re claims **14** and **28**, Eggleston teaches receiving, from the first participant, a request to process a second transaction involving the first participant and a third participant using the

first currency that is not recognized by the third participant; decrementing an additional amount of the first currency associated with the first participant; incrementing an amount of third currency associated with the first participant, wherein the third currency is recognized by the third participant; and processing the second transaction using the amount of the third currency (col. 44, line 64 to col. 45, line 67; col. 46, lines 4-55).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday from 6am-2pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Thu Thao Havan/
Art Unit 3693
9/18/08

Application Number**Application/Control No.**

09/854,423

**Applicant(s)/Patent under
Reexamination**

TSO, MICHAEL M.

Examiner

THU-THAO HAVAN

Art Unit

3693